

REMARKS

Claims 1-6 remain pending in the present invention. The Specification and Claims 1 and 6 have been amended. Basis for the amendments can be found throughout the specification, claims and drawings as originally filed. The Examiner is respectfully requested to reconsider and withdraw the rejection(s) in view of the amendments and remarks contained herein.

DRAWINGS

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on December 20, 2002, have been disapproved because they introduce new matter into the drawings.

The specification on page 12, paragraph 29 states that it is within the scope of the present invention, as shown in Figure 5, to incorporate valve assembly 64 on **either** side of piston 32 if desired. On page 10, paragraph 24, it states that valve assembly 64 comprises a variable orifice bleed disc 90 and a supporting disc 92. Thus, it is clear that valve assembly 64 must include at least disc 90 and 92 and that discs 90 and 92 can be located on **either** side of piston 32. Original Figure 5 identifies valve assembly 64 as being located on the lower side of piston 32 and, therefore, the two discs on the lower side of piston 32 can only be discs 90 and 92. To define these two discs using any other reference numerals expands the definition of valve assembly 64 and leaves out either disc 90 or 92. This type of definition of valve assembly 64 clearly lacks support in the specification.

While not proposed by the Applicants, it could be argued that the valve assembly located on the top of piston 32 could also be labeled at valve assembly 64 because the specification provides support for placing valve assembly 64 on **either** side of piston 32. Thus, the position by the Examiner that there are four discs associated with valve assembly 64 is clearly erroneous and traversed because of the term "either" in the specification. While all four disc could be associated with two valve assemblies 64, clearly Figure 5 illustrates only the two discs on the bottom of piston 32 are associated with valve assembly 64 and these two valve disc have to be discs 90 and 92. *} 2 disc on one disc*

The Examiner's position that different discs **must** be associated with the piston valve assembly is clearly erroneous and traversed. Both the piston 32 and the base valve body 60 are located with pressure tube 30 and are, thus, similar in size. They both close the radially inner passages (74 in the base valve). Bolt 66 secures the base valve and the nut secures the piston. Applicants do not understand why these discs **must** be different, since it appears that having them identical is clearly an option.

Reconsideration and approval of the previously-filed drawing correction is respectfully requested.

SPECIFICATION

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. The specification has been amended to overcome the objection.

Withdrawal of the objection is respectfully requested.

35 U.S.C. § 112, first paragraph, requires the specification to be written in “full, clear, concise, and exact terms.” Applicants have reviewed the specification and has amended it where “full, clear, concise, and exact terms” were not used.

Withdrawal of the objection is respectfully requested.

REJECTION UNDER 35 U.S.C. § 112

Claim 6 is rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This rejection is respectfully traversed.

Claim 6 has been amended to define the mid/high speed valve as including only two valve discs, the two valve discs being the first and second valve discs. Applicants believe this revised wording allows the mid/high speed valve to include additional components, but none of these components can be an additional valve disc.

Reconsideration of the rejection is respectfully requested.

Claims 1-3 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. This rejection is respectfully traversed.

Claim 1 has been amended to correct the typographical error. Likewise, Claims 2 and 3, which ultimately depend from Claim 1, have been amended to correct the typographical error.

Reconsideration of the rejection is respectfully requested.

REJECTION UNDER 35 U.S.C. § 103

Claims 1-5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Furuya et al.* (U.S. Pat. No. 5,042,624) in view of *Tanaka* (U.S. Pat. No. 5,529,154) and *Yamaura et al.* (U.S. Pat. No. 4,964,493). This rejection is respectfully traversed.

The Examiner is relying on *Tanaka* to provide the chordal edge. Her position is that the outer edge forming recess 19a could be configured as a chord. The problem with this position is that if the outer edge of recess 19a were a chord as proposed by the Examiner, recess 19a would no longer exist. As stated previously, a recess is an indentation or small hollow; and a chordal outer edge would clearly not define an indentation or a small hollow.

The Examiner then goes to *Yamaura et al.* to find a second valve disc 144 which is adjacent a first valve disc 138 via elements 147. The problem with this position is that plate 144 is not **adjacent** the first valve disc 132, but spaced from it by washer 142. The Examiner then states that the second valve disc has an outer edge that supports the first valve disc. Applicants respectfully request the Examiner to indicate which figure of *Yamaura et al.* provides support for this position. Applicants have reviewed all of the figures of *Yamaura et al.* and are unable to determine which figure supports the Examiner's position.

The Examiner is relying on hindsight to arrive at the determination of obviousness. The court in *In Re Fritch*, 23 USPQ 2d 1784 (Fed. Cir. 1992), stated that it is impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This is exactly what the Examiner has done here. The Examiner has pieced

together the three references to allegedly render Applicants' invention obvious, which is clearly shown due to the fact that the prior art even lacks some of the limitations of the claimed invention as discussed above.

Thus, Applicants believe Claim 1 patentably distinguishes over the art of record. Likewise, Claims 2-5, which ultimately depend from Claim 1, are also believed to patentably distinguish over the art of record.

Reconsideration of the rejection is respectfully requested.

Claim 6 is rejected under 35 U.S.C. § 103(a) as unpatentable over *Yamaura et al.* in view of *Tanaka*. This rejection is respectfully traversed.

The discussion above regarding *Yamaura et al.* and *Tanaka* apply equally well here. This prior art fails to teach the limitations of the claims without resorting to impermissible hindsight.

Thus, Applicants believe Claim 6 patentably distinguishes over the art of record.

Reconsideration of the rejection is respectfully requested.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the

Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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